

Remarks/Arguments

As of the Office Action of 29 April 2004 (the "Final Action"), Claims 1-3, 16-18, and 20-22 are pending in the Application and stand rejected. Claims 24-26 and 35-102 are withdrawn from consideration.

Applicant herein amends Claims 1-3, 16-18, and 20-22. Applicant has so amended said Claims so as to more clearly recite the claimed subject matter. Applicant has not amended said Claims so as to distinguish the claimed subject matter from cited references (i.e., Applicant understands that such references are not directed to the subject matter of said Claims). In any case, the amendments to the Claims are not intended to, and do not, narrow the claimed scope of the Application.

Applicant submits that these amendments add no new matter.

Applicant notes that the Claims, as amended, include three (3) independent claims and nine (9) total claims. As such, no excess claims fees are due.

Applicant further notes that this Preliminary Amendment is being filed in an RCE, which RCE is submitted in connection with a Petition for Revival of this Application. As such, no extension of time is required. However, if any such extension of time is determined to be required, this shall serve as a request for said required extension, pursuant to 37 CFR 1.136, and any fees associated with said required extension are authorized herein, pursuant to the ultimate paragraph of this Preliminary Amendment.

In view of the Claims as set forth above and the remarks below, Applicant respectfully requests reconsideration and further examination of this Application.

Rejection of Claims for Obviousness-Type Double Patenting. The Final Action rejected Claims 1-3, 16-18 and 20-22 under the judicially-created doctrine of obviousness-type double patenting, as being unpatentable over claims 1 and 2 of U.S. Patent No. 6,100,920. The Final Action reasons by conclusion, stating only that the claims "of the present application are broader and encompassing of the patented claims of the parent patent." The previous Office action, dated 21 January 2004 (the "First Action"), also reasons by conclusion, stating only that "the claims in the application are broader than the ones in the patent."

Nowhere has the First or Final Actions set forth analysis to support these conclusions. That is, the Actions omit to inform Applicant of the rejection's particulars, which particulars are needed to fairly enable proper response. Those particulars must parallel those of a prima facie

case for an obviousness rejection under a 35 U.S.C. 103(a). Indeed, such parallel particulars are required under MPEP Section 804(II)(B) which states:

Since the analysis employed in an obviousness-type double patenting determination parallels the guidelines for a 35 U.S.C. 103(a) rejection, the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103 are employed when making an obvious-type double patenting analysis. These factual inquiries are summarized as follows:

(A) Determine the scope and content of a patent claim ** relative to a claim in the application at issue;

(B) Determine the differences between the scope and content of the patent claim ** as determined in (A) and the claim in the application at issue;

(C) Determine the level of ordinary skill in the pertinent art; and

(D) Evaluate any objective indicia of nonobviousness.

The conclusion of obviousness-type double patenting is made in light of these factual determinations.

Any obviousness-type double patenting rejection should make clear:

(A) The differences between the inventions defined by the conflicting claims - a claim in the patent compared to a claim in the application; and

(B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim **>at issue would have been< an obvious variation of the invention defined in a claim in the patent.

Moreover, although required under *In re Kaplan* (789 F.2d 1574, 229 USPQ 678 (Fed. Cir. 1986)), the First and Final Actions fail both (a) to establish the variations between the claimed inventions of the Application and the cited patent (i.e., not the variations in the language of such claims) and (b) a prima facie case of obviousness as to the Application's claimed invention in light of the patent's claimed invention. In omitting any such showings, it must be understood that the Actions improperly use the patent's disclosure as prior art to reach the rejection.

In view of the infirmities of the non-statutory double-patenting rejection, Applicant traverses the rejection as to the current Claims.

Moreover, in the absence of any indication of allowable Claims, Applicant is compelled to decline to file a Terminal Disclaimer. Applicant notes that, without having allowable Claims to consider, a non-statutory double-patenting analysis is premature.

Applicant reserves the right to file a Terminal Disclaimer as to allowable Claims at the time that allowability is indicated except for a proper, non-statutory double-patenting rejection.

Rejection of Claims as to Cited References. The Actions reject Claims 1-3, 16-18 and 20-22 variously under 35 U.S.C. §§ 102(b) and 103(a) as being unpatentable based on Flagle, U.S. Patent No. 3,654,385 ("Flagle"), including in view of Topper et al., U.S. Patent No. 5,157,497 ("Topper").

Applicant has amended Claims which amendments more clearly recite the claimed subject matter so that the Office may properly interpret such claims in its examination. In light of that, Applicant understands that the Actions' rejections on cited references are moot.

Even so, Applicant submits that the Actions provide no case for the cited references teaching or suggesting the subject matter of the amended Claims. As an example, independent Claims 1, 16 and 20 each recite limitations substantially directed to (i) compensating a video signal representing an optical image of a target site, the target site being subject to uneven illumination from an endoscope, so that (ii) an output video signal represents an optical image of the target site were the target site to have a substantially uniform illumination from the endoscope.

Such Applicant's limitations are neither taught nor suggested by the Actions' designations to the cited references. Indeed, Flagle proposes only to correct inherent shortcomings within its camera. These shortcomings exist due to the camera's image acquisition components. These shortcomings have nothing to do with illumination of a target site. These shortcomings continue regardless of the target site's illumination, i.e., whether uniform or uneven. These shortcomings apparently exist even if the target site is not illuminated.

Flagle simply shows no appreciation for the problems recognized by Applicant as to illumination of a target site from an endoscope. Indeed, even if a camera corrected the camera's shortcomings as proposed by Flagle, the camera's output video signal would yet fail to represent an optical image of the target site as if the target site were substantially uniformly illuminated. That is, Flagle simply does not appreciate the illumination problem and, as such, cannot teach or suggest a solution to that problem.

Accordingly, Applicant respectfully submits that the Actions' designations to the cited references neither teach nor suggest the independent Claims.

As well, Applicant submits that the Application's dependent Claims are also neither taught nor suggested by the Actions' designations to the cited references, e.g., because each

such Claim depends ultimately from, and thereby includes at least the limitations of, the independent Claims.

Rejection of Claims as to "Admitted Prior Art". The Actions reject Claims 1-3, 16-18 and 20-22 variously under 35 U.S.C. §§ 102(a) and 103(a) as being unpatentable based on Applicant's "admitted prior art", including in view of Topper et al., U.S. Patent No. 5,157,497 ("Topper"). (For purposes of this part of the Preliminary Amendment, "admitted prior art" is henceforth referenced as the "Background", because the Actions identify such "admitted prior art" as being Applicant's descriptions of pages 2-7 of the Application, which pages are part of the Background section of the Application; this term is not an admission that any particular part of such Background is actually prior art, let alone prior art relevant to the claimed subject matter of this Application.)

Applicant has amended Claims which amendments more clearly recite the claimed subject matter so that the Office may properly interpret such claims in its examination. In light of that, Applicant understands that the Actions' rejections based on the Background are moot.

Even so, Applicant submits that the Actions provide no case for the Background, alone or together with Topper, teaching or suggesting the subject matter of the amended Claims. As an example, independent Claims 1, 16 and 20 each recite limitations substantially directed to (i) compensating a video signal representing an optical image of a target site, the target site being subject to uneven illumination from an endoscope, so that (ii) an output video signal represents an optical image of the target site were the target site to have a substantially uniform illumination from the endoscope.

Such Applicant's limitations are neither taught nor suggested by any part of the Background. Rather, the Background—as expected in any patent application—sets out problems in endoscopy relating to illumination of the target site, as well as various approaches to address such illumination problems. The described approaches, e.g., are directed to the light source and/or delivering the source's light to the target site. The described approaches fail entirely to teach or suggest compensating the video signal representing the optical image of the unevenly illuminated target site so as to produce a video signal representing the optical image were the target site to have been substantially uniformly illuminated.

In addition, the Background makes note of shortcomings inherent in cameras. These are in the category of the shortcomings of Flagle. That is, these shortcomings exist inherently within the camera, due to the camera's image acquisition components. These shortcomings

have nothing to do with illumination of a target site. These shortcomings continue regardless of the target site's illumination, i.e., whether uniform or uneven. These shortcomings apparently exist even if the target site is not illuminated.

In the Background, as with Flagle, the cameras do not correct the problems as to illumination of a target site from an endoscope. Indeed, even if the camera's inherent shortcomings were corrected, the Background makes clear that the camera's output video signal would yet fail to represent an optical image of the target site as if the target site were substantially uniformly illuminated. That is, the Background sets forth that a camera's inherent shortcomings may be corrected, but doing so will have no impact on problems associated with illumination of the target site. As such, the Background neither teaches nor suggests a solution to the illumination problem.

Accordingly, Applicant respectfully submits that the Actions' designations to the Background fail to teach or suggest the independent Claims.

As well, Applicant submits that the Application's dependent Claims are also neither taught nor suggested by the Actions' designations to the Background, e.g., because each such Claim depends ultimately from, and thereby includes at least the limitations of, the independent Claims.

CONCLUSION

Accordingly, Applicant respectfully submits that, in view of the foregoing remarks and/or amendments, the Claims pending in the Application are in condition for allowance. Applicant respectfully requests reconsideration and favorable action.

Generally, in this Preliminary Amendment, Applicant has not raised all possible grounds for (a) traversing the rejections of the Action or (b) patentably distinguishing the new Claims (i.e., over the Cited References or otherwise). Applicant, however, reserves the right to explicate and expand on any ground already raised and/or to raise other grounds for traversing and/or for distinguishing, including, without limitation, by explaining and/or distinguishing the subject matter of the Application and/or any cited reference at a later time (e.g., in the event that this Application does not proceed to issue with the Claims as herein amended, or in the context of a continuing application). Applicant submits that nothing herein is, or should be deemed to be, a disclaimer of any rights, acquiescence in any rejection, or a waiver of any arguments that

might have been raised but were not raised herein, or otherwise in the prosecution of this Application, whether as to the original Claims or as to any of the new Claims, or otherwise. Without limiting the generality of the foregoing, Applicant reserves the right to reintroduce one or more of the original Claims in original form or otherwise so as to claim the subject matter of those Claims, both/either at a later time in prosecuting this Application or in the context of a continuing application.

The Commissioner is hereby authorized to charge any fees, including extension fees, or to charge any additional fees or underpayments, or to credit any overpayments, to the Credit Card account referenced on the accompanying Credit Card Payment form (PTO-2038). As an alternative, in case the Credit Card cannot be processed, the Commissioner is hereby authorized to charge any fees, additional fees, or underpayments, or to credit any overpayments, to Deposit Account No. 50-1001.

Respectfully submitted,



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